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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

KANG, INSUN

ART UNIT PAPER NUMBER

2193

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,135

Applicant(s)

FORDEMWALT ET AL.

Examiner

Insun Kang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed 3/15/2005.
2. Claims 1-12 and 14-21 are pending in the application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-11, 14-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,681,392 to Henry et al. hereinafter referred to as "Henry."

Per claim 8:

Henry teaches:

- installing a device driver and an associated peripheral software designed to accompany the device driver on a client computer over a network ("driver software and other control software required by the peripheral devices," col 1 lines 35-41; see also col 2 lines 6-8 and 49-53).
- providing at least one peripheral installed on a remote computer ("peripheral devices...used on the network," col 1 lines 35-41; col. 6 lines 35-67)
- a device driver being for said at least one peripheral, and said associated peripheral software being for said at least one peripheral ("driver software and

other control software required by the peripheral devices," col 1 lines 35-41; see also col 2 lines 6-8 and 49-53)

Henry discloses a script that is a "list of instructions to automatically install software with specific selections (col. 4 lines 56-67)." The script can be specified to include a particular installation procedure. Therefore, It would have been obvious for one having ordinary skill in the pertinent art to modify Henry's script to be directed to read a description file associated with said at least one peripheral ("a script...containing a list of commands...[and] instructions to automatically install software with specific selections," col 4 lines 56-67; see also col 6 lines 23-34) in response to an initialization of said device driver during an installation of said device driver on said client computer ("Standard operating system function calls are used to access the information needed from the remote system...to communicate to the driver being initialized on the remote system, that the install is a remote install," col 5 lines 44-58; col. 4 lines 38-67; col. 5 lines 1-6; col. 6 lines 35-67) and to install said peripheral software on said client computer in response to an installation procedure of said peripheral software included in said description file ("The install program sets values in the remote registry signaling to the driver that the install is a remote install and that any initialization requiring user intervention must be suppressed; col 5 lines 48-58; "determining which software is to be part of the installation and which options are to be applied...by executing a script file," col 6 lines 21-34; col. 4 lines 38-67; col. 5 lines 1-6) in order to insure installation of the driver and its associated utilities.

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Henry further discloses completing installation of the device driver on the client computer ("installation can be completed without rebooting," abstract) as claimed.

Per claim 9:

The rejection of claim 8 is incorporated, and further, Henry teaches:
- said initialization comprises an operating system call for said device driver to initialize itself ("Standard operating system function calls are used to access the information needed from the remote system...to communicate to the driver being initialized on the remote system, that the install is a remote install," col 5 lines 44-58) as claimed.

Per claim 10:

The rejection of claim 9 is incorporated, and further, Henry teaches: modifying said device driver to read said description file as the script can be specified in a particular way as addressed above ("a script...containing a list of commands...[and] instructions to automatically install software with specific selections," col 4 lines 56-67; see also col 6 lines 23-34) col. 4 lines 38-67; col. 5 lines 1-6; "For a remote install...any initialization requiring user intervention must be suppressed," col 5 lines 48-58; see also col 5 lines 1-18; col 6 lines 23-34) as claimed.

Per claim 11:

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The rejection of claim 10 is incorporated, and further, Henry teaches that said at least one peripheral is a printer ("printer driver," col 4 line 49) as claimed.

Per claims 2-6, they are another method versions of claims 8-12, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 8-12 above.

Per claim 7:

The rejection of claim 1 is incorporated, and further, Henry teaches initiating installation of said peripheral by selecting a UNC path name configured to represent said peripheral ("a universal naming convention (UNC) is used," col 5 lines 19-40) as claimed.

Per claims 14 and 17-20, they are the system versions of claims 1,3, and 5-7, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 1,3, and 5-7 above.

Per claim 15:

The rejection of claim 14 is incorporated, and further, Henry teaches that said initialization is configured to invoke an initialization entry point configured to point to said description file ("Standard operating system function calls are used to access the information needed from the remote system...to communicate to the driver being initialized on the remote system, that the install is a remote install," col 5 lines 44-58; "For a remote install...any initialization requiring user intervention must be suppressed,"

col 5 lines 48-58; see also col 5 lines 1-18; col 6 lines 23-34; "The install program sets values in the remote registry signaling to the driver that the install is a remote install and that any initialization requiring user intervention must be suppressed; col 5 lines 48-58; "determining which software is to be part of the installation and which options are to be applied...by executing a script file," col 6 lines 21-34; col. 4 lines 38-67; col. 5 lines 1-6) as claimed.

Per claim 16:

The rejection of claim 14 is incorporated, and further, Henry teaches that said at least one processor is further configured to install said associated peripheral software according to an installation procedure included in said description file ("The install program sets values in the remote registry signaling to the driver that the install is a remote install and that any initialization requiring user intervention must be suppressed; col 5 lines 48-58; "determining which software is to be part of the installation and which options are to be applied...by executing a script file," col 6 lines 21-34; col. 4 lines 38-67; col. 5 lines 1-6) as claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,681,392 to Henry et al. hereinafter referred to as "Henry" in view of Applicant's Admitted Prior Art (hereinafter referred to as "APA") disclosed in the instant application.

Per claims 6:

The rejection of claim 1 is incorporated, and further, Henry does not explicitly teach initiating installation of the peripheral by activating an icon representing the peripheral as claimed. APA discloses that it was known in the art of software distribution and installation, at the time applicant's invention was made, to install a peripheral device remotely such as those disclosed in Henry, by using an icon representing the peripheral ("Any user on the network may install a device driver for a selected peripheral by selecting an icon representing that peripheral," pg 3 lines 1-9 in APA) so that selection of the desired device to install and locating its device driver can be easily accomplished. It would have been obvious for one of ordinary skill in the art of computer software development and distribution to modify Henry's disclosed system to use an icon disclosed in APA for initiating installation of the peripheral by simply clicking the icon representing the peripheral. The modification would be obvious because one of ordinary skill in the art would be motivated to use an icon so that installation of network

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peripheral can be done easily without requiring a user to search the desired peripheral and the location of its device driver.

Per claim 12:

It is another method version of claim 6, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 6 above.

Per claim 19:

It is the system version of claim 6, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 6 above.

Response to Arguments

7. Applicant's arguments filed 3/15/2005 have been fully considered but they are not persuasive.

Per claims 1, 8, and 21:

The Applicant recites that:

Henry still does not say anything about installing a utility in response to initializing the device driver...There is no teaching in Henry that his script file could be used to install a utility in response to initializing the device driver...Henry teaches only that his script file includes a list of software and instructions to automatically install the software (remark, page 9). Nothing in this passage of Henry...suggests reading the script file in response to initialization of the driver (remark, page 10).

In response, although the applicant argues that any utilities or programs that can be related to a specific driver can be considered to be "separate from a driver but

designed to accompany the driver” in the amendment filed 11/22/2004, the claims do not recite what the associated peripheral software or the “utility” is. Further, the claims do not use the term, a “utility.” Still further, the utility can be any files consisting of the driver or any associated “auxiliary” program that is “separate from a driver” but related to the driver. The preamble recites that “an associated peripheral software” is “designed to accompany the device driver.” However, this is a very broad description. Any files consisting of the driver can be considered as the associated peripheral software designed to accompany the driver. Also, the recitation “designed to accompany the device driver” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure (“A method for installing”), and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Also, it is noted that the features upon which applicant relies (i.e., separate from a driver but designed to accompany the driver; utility) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Henry specifically teaches that “Install engine 702 retrieves a list of software to install from installation GUI 701 during the installation process for determining which software is to be part of the installation and which options are to be applied,” col. 6 lines

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23-33 and "software and options for installation on the remote system are determined.... so the software includes printer drivers and network utilities. Either or both of these types of software may be installed according to certain installation options," col. 4 lines 46-67). Henry's script is a self-executable file "containing a list of commands that can be executed without user interaction... a script is a list of instructions to automatically install software with specific selections (col. 4 lines 56-67 and col. 5 lines 1-6)." The script can be written with any particular lists of commands and Henry states that both of drivers and utilities can be installed using the script. Therefore, the script can contain instructions to install both drivers and utilities. Further, Henry teaches that "standard operating system function calls are used to access the information needed from the remote system... and to communicate to the driver being initialized by an operating system (col. 5 lines 44-58)." In Henry, the "install program sets values in the remote registry signaling to the driver that the install is a remote install and that any initialization requiring user intervention must be suppressed (col 5 lines 48-58)." In response to the automatic initialization, the step of "determining which software is to be part of the installation and which options are to be applied... by executing a script file (col 6 lines 21-34; col. 4 lines 38-67; col. 5 lines 1-6)" is performed and the installation is completed. If applicant means anything more, this must be brought out in the claims to further clarify the invention.

Accordingly, in view of the broadest reasonable interpretation above, Therefore, the rejections of claims 1, 8, and 21 are maintained.

Per claims 2, 4, 10:

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 571-272-3724. The examiner can normally be reached on M-F 9:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on 571-272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

I. Kang
Examiner
AU 2193


KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100